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**OFFICE OF PETITIONS**

In re Application of	:	
Rovira et al.	:	DECISION ON APPLICATION
Application No. 10/027,940	:	FOR
Filed: December 19, 2001	:	PATENT TERM ADJUSTMENT
Attorney Docket No. M-12332 US	:	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT," filed February 6, 2006. Applicants request that the initial Determination of Patent Term Adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to five hundred fifty (550) days.

The application for patent term adjustment is **GRANTED to the extent indicated herein.**

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is three hundred seventy-five (**375**) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On November 10, 2005, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicants were advised that the patent term adjustment to date is zero (0) days. In response, applicants timely<sup>1</sup> filed the instant request for reconsideration of the patent term adjustment along with payment of the fee set

<sup>1</sup> PALM Records indicate that the Issue Fee payment was received on February 6, 2006.

forth in 37 CFR 1.18(e). Applicants request that the patent term adjustment be corrected to 550 days. Applicants assert that the Office's delay pursuant to 37 CFR 1.703(a)(2) should be calculated as 339 days, not 0 days. Further, applicants dispute the reduction pursuant to 37 CFR 1.704(b) of 278 days on the ground that they did not fail to engage in reasonable efforts to conclude examination of the application.

Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

The application history has been reviewed and it has been determined that the initial patent term adjustment of zero (0) days is incorrect. The Office mailed an Office action under § 111 on March 2, 2004, within four months after the date of the filing of applicants' reply, December 2, 2003. However, the Notice was not mailed to the correspondence address of record. The record supports a conclusion that this was due to an error on the part of the Office in mailing the Office action to applicants. Accordingly, a letter restarting the period for reply (and re-mailing the Office action) was mailed on December 6, 2004.

Thus, the Office's delay should be calculated using the date of December 6, 2004. However, the period of delay is 249 days, not 339 days. Applicants' response was received on December 1, 2003. Thus, the period of adjustment is 249 days, the number of days in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed, April 2, 2004, and ending on the date of mailing of an action under 35 U.S.C. 132, December 6, 2004.

However, applicants failed to engage in reasonable efforts within the meaning of § 1.704(b). Their response filed March 7, 2005, was received three months and one day after the date of the mailing of the Office action as re-mailed on December 6, 2004. Accordingly, a period of reduction of 1 day, not 278 days should have been entered.

The Office further notes that pursuant to 37 CFR 1.704(c)(8), the submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, is a failure to engage in reasonable efforts to conclude prosecution. It is

undisputed that after filing a response on December 1, 2003, on March 5, 2004, applicants filed a supplemental Information Disclosure Statement (IDS). The record does not support a conclusion that the IDS was expressly requested by the examiner.

A review of the IDS filed March 5, 2004, reveals that it did not include a § 1.704(d) statement.<sup>2</sup> Thus, the period of reduction of 84 days, beginning on the day after the date the initial reply was filed, December 2, 2003, and ending on the date that the supplemental reply or other such paper was filed, March 5, 2004, is warranted.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is 375 days.

Submission of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fee is required.

Applicants are reminded that any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. Further, in considering the overlap, the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining

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<sup>2</sup> Applicants are reminded that § 1.704(d) was revised, effective May 24, 2004, as follows:

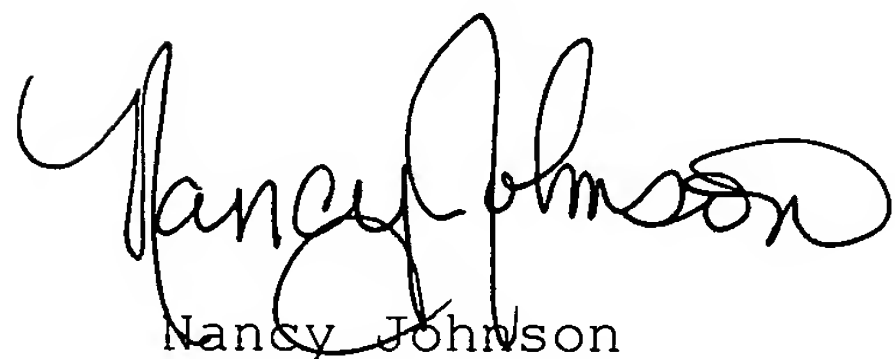
A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

This revision requires that the statement include the language "each item of information contained in the information disclosure statement was first cited ..." for the exception to apply. See 69 FR 21704, Apr. 22, 2004.

whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). See 35 U.S.C. 154(b)(1)(B); 35 U.S.C. 154(b)(2)(A); and 37 CFR 1.703(f).

The Office of Patent Publication has been advised of this decision. This matter is, thereby, being referred to the Publishing Division for issuance of the patent.

Telephone inquiries regarding this matter should be directed to Christina Tartera Donnell, Senior Petitions Attorney, at (571) 272-3211.

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is fluid and cursive, with the first name "Nancy" written in a larger, more prominent script than the last name "Johnson".

Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

Enclosure: Copy of updated PAIR screen